

**Remarks:**

1. Two paragraphs in the specification have been amended to correct typographical errors.
2. Claims 10, 11, 12, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nassar et al.
  - a. Regarding claim 10, applicant respectfully points out that there are distinct advantages to the novel bit map that is claimed. None of the prior art teaches or discloses having all of the bits change as the transmission is shifted from Park to Reverse. This gives the controller the ability to immediately diagnose if one or more of the detectors are not operating properly on the first shift from Park to Reverse. In the prior art, it would take several shift changes to diagnose that one of the detectors was not operating properly. Applicant contends that this is patentably distinguishable over the prior art, being neither disclosed nor suggested in the prior art, and therefore non-obvious. The Examiner's contention that it would have been merely a design choice to set up the bit map to operate in the claimed fashion seems to be over-reaching. The prior art does not even suggest the desirability of being able to diagnose the system on the initial shift with all of the bits changing on the shift from Park to Reverse. Quoting from the MPEP, section 2143.01 under the paragraph entitled "FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH *PRIMA FACIE OBVIOUSNESS*", "Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a

suggestion or motivation in reference to do so.” 916 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

- b. Regarding claims 11-16, as these claims depend from claim 10, for at least the reasons cited above, applicant contends that these claims are in condition for allowance.
  3. Claims 5- 9, 13, 17, and 20- 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nassar in view of Santos et al. (Santos; US Patent 5,307,013).
    - a. Regarding Claim 5, the instant invention, requiring all of the bits to change when the transmission is shifted from Park to Reverse is an important improvement on the disclosure of Nassar, allowing the controller to detect immediately if one of the detectors or its associated circuitry is not operating properly. The Examiner’s contention that it would have been merely a design choice to set up the bit map to operate in the claimed fashion seems to be over-reaching. The prior art does not even suggest the desirability of being able to diagnose the system on the initial shift with all of the bits changing on the shift from Park to Reverse. Quoting from the MPEP, section 2143.01 under the paragraph entitled “FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS”, “Although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in reference to do so.” 916 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

- b. Re claim 6, claim 6 has been amended to clarify what was previously called “drive” as the adjacent forward drive position to “neutral”. The instant application shows “drive” as the first occurring forward drive position adjacent to “neutral” (Illustration on page 8). Nassar referred to the same position as “OD” or “OverDrive” (Fig. 4). The Examiner asserts that Nassar and Santos disclose all of the claimed limitations. However, applicant respectfully points out that the “OD” position of Nassar is analogous to the “D” position of the instant application. Both are the first forward driving position that is encountered when the transmission is moved out of the Neutral position. This allows the system to detect any problem before the vehicle is engaged in a forward moving mode. None of the prior art discloses or suggests purposefully changing all of the bits on this action in order to immediately detect a problem and take corrective action. Applicant contends that the instant invention is patentably distinguished over Nassar and Santos.
- c. Regarding claims 7 and 8, both of these claims depend from claim 5, so applicant contends that for at least the reasons cited above they are in condition for allowance.
- d. Regarding claim 9, claim 9 depends from claim 8, so applicant contends that for at least the reasons cited above, claim 9 is in condition for allowance.
- e. Regarding claim 13, see point 2(b) above.
- f. Regarding claim 17, the instant invention, requiring all of the bits to change when the transmission is shifted from Park to Reverse is an important improvement on the disclosure of Nassar, allowing the controller to detect immediately if one of

the detectors or its associated circuitry is not operating properly. The Examiner's contention that it would have been merely a design choice to set up the bit map to operate in the claimed fashion seems to be over-reaching. The prior art does not even suggest the desirability of being able to diagnose the system on the initial shift with all of the bits changing on the shift from Park to Reverse. Quoting from the MPEP, section 2143.01 under the paragraph entitled "FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS", "Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in reference to do so." 916 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). Applicant contends that claim 17 is in condition for allowance.

- g. Re claim 20, claim 20 has been amended to depend from amended claim 17. Therefore, for at least the reasons cited in point 3(f) above, applicant contends that claim 20 is in condition for allowance.
- h. Re claims 21 and 22, both claims have been amended to depend from amended claim 17. Therefore, for at least the reasons cited in point 3(f) above, applicant contends that claims 21 and 22 is in condition for allowance.
- i. Claim 23 depends from amended claim 22 and therefore for the reasons cited above, applicant contends it is in condition for allowance.

4. Claims 4 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nassar in view of Dourra et al. (Dourra; US Patent 6,072,390).

- a. Re claim 4, applicant contends that it is improper to combine Nasser in view of Dourra. Dourra clearly teaches away from Nassar, mentioning it by name and describing its shortcomings in Column 2, lines 1-56. Dourra then goes on to explicitly teach and claim that at least five detectors are required (Col. 3, line 2). The instant invention has accomplished the result of Dourra without the need for at least five detectors. For this reason, applicant believes that it is improper to cite Nassar in view of Dourra, and contend that claim 4 is in condition for allowance.
- b. Regarding claim 24, the same argument as 4(a) above applies. For this reason, applicant contends that amended claim 24 is in condition for allowance.
- c. Re claim 25, amended claim 25 depends from amended claim 24. Therefore, for at least the reasons cited in point 4(b), applicant contends that amended claim 25 is in condition for allowance.
- d. Re claim 26, claim 26 depends from amended claim 25. Therefore, for at least the reasons cited in point 4(c), applicant contends that claim 26 is in condition for allowance.

Applicants appreciate the Examiner's thorough examination of the instant application. Applicant believes that the application is now in condition for allowance and looks forward to a timely Notice of Allowance.

Appl. No. 10/602,788  
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Although no fees are believed due, the Commissioner is authorized to charge our Deposit Account No. 50-0831 for any fees or credit the account for any overpayment.

Respectfully submitted,

By



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